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7590

09/30/2003

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EXAMINER

EL ARINI, ZEINAB

ART UNIT

PAPER NUMBER

1746

DATE MAILED: 09/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/942,317

Applicant(s)

PHAM, THUAN

Examiner

Zeinab E. EL-Arini

Art Unit

1746

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 31-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-40 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-30 are, drawn to an apparatus for cleaning a part, classified in class 134, subclass 56R.
- II. Claims 31-40 are, drawn to a method of cleaning the probe tip of a coordinate measuring machine, classified in class 134, subclass 18.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another process such as a process of washing hand or a process for washing dental instruments.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with MR. Brad Schepers on 9/3/03 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-30. Affirmation of this election must be made by applicant in replying to this Office action. Claims 31-40 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. In claims 1-4, 9, 11, 13-15, 21-23, and 26, "adapted to" is indefinite term, because it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

In claims 8 and 12, "generally" is indefinite term, and in claim 12, "substantially" is indefinite term.

### ***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-9, 11-13, 16-17, and 26-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Deibert (6,431,189).

Deibert teaches an apparatus for disinfecting a user's hands comprising: a housing; a spray means; a supply means for supplying a liquid to the spray means; a valve means; a sensor means for sensing the presence of a user's hands within the spray chamber; and a control circuit including a first timer and connected to the sensor means and the valve means. The control circuit being adapted to open the valve means to supply the liquid to the spray means when the sensor means detects the presence of a user's hand and maintaining the valve means open for a period determined by the first timer. The valve means, when open, mixing the concentrated solution and water in a desired ratio, to form said liquid which is supplied to the spray means. See col. 2, lines 25-65, and col. 3, lines 8-20. The reference also teaches forming part of the electronic circuitry is a photoelectric proximity sensor. See col.5, lines 16-37, lines 60-65, and the claims. The limitation of claims 11 and 12 are inherent in the Deibert's sensor. With respect to the recitation of "apparatus for cleaning", in claims 1, 21, 26, and "the part is a measurement probe", in claim 17, it is for intended use recitation. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying

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the claimed structural limitations. See parte Masham, 2 USPQ 2d 1647 (1987).

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-9 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Vetter (4,688,585).

Vetter teaches an automatic washer for washing articles comprising a housing; nozzle means including at least one nozzle; a sensor to detect the position of the article or the object to be cleaned, and to generate a control signal in response thereto, and a valve. See the abstract, col. 2, lines 3-36, col. 3, line 13- col. 4, line 51, col. 5, lines 13-45, col. 6, lines 27-36, and the claims.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1-18, and 20-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Biancalana et al. (4,552,163).

Biancalana et al. teach a device for cleaning, disinfecting and drying instruments. The device comprises a housing; at least one nozzle, a sensor adapted to detect a presence of the object to be cleaned; and a valve as claimed. The reference teaches that when the instrument is introduced into

the chamber under the control of the photoelectric cells, the operative cycle starts and the valves 33, 34 open, thus providing pressurized air and water to the nozzles 10, so that pressurized air reaches said nozzles. At the same time valve 35 opens, therefore the atomizer 12 starts to work and a flow of air containing disinfectant reaches the nozzles 11. After the predetermined washing time, the electro-valves 33 and 34 close. The reference also teaches water-air mixing unit. See col. 4, lines 54-64, col. 3, lines 51-56, and claims 1 and 6. The limitation of claim 17 is for intended use limitation.

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 19, and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Biancalana et al. in combination with Benedict et al. (5,339,843).

Biancalana et al. as discussed supra teach all limitation with the exception of the cleaning agent is isopropyl alcohol.

Benedict et al. teach a cleaning system for cleaning parts with cleaning liquid comprising alcohols. See the abstract, col. 1, lines 22- 59.

It would have been obvious for one skilled in the art at the time applicant invented the claimed apparatus to use the alcohol taught by Benedict et al. in the apparatus taught by Biancalana et al. to obtain the claimed invention. This is because using alcohols for cleaning instruments is well known in the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zeinab E. EL-Arini whose telephone number is (703) 308-3320. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (703) 308-4333. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

*Zeinab E. EL-Arini*

Zeinab E. EL-Arini  
Primary Examiner  
Art Unit 1746

ZEE  
9/22/03